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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,350	01/11/2002	Denis Cotteville	Q68000	6289

7590 06/20/2003

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,350

Applicant(s)

COTTEVILLE ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 to 8 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____



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Please find below and/or attached an Office communication concerning this application or proceeding.

1. At first, the Examiner would like to note that applicants appear to be reading more limitations into the claims than are actually there. First, note that the second coupling agent need only have groups that are "suitable" for reacting with the hydroxyl first groups. This does not require that the prior art clearly state that the groups must undergo reaction with one another. Second, there is no requirement that the composition be homogeneous. Also, applicants appear to be reading more into the first coupling agent than is there. The claim defines this agent only as requiring hydroxyl functional groups. In addition, the phrase "resistant to tearing" is extremely broad and does not lend much in the way of limitations to this claim. This does not require any degree of resistance and a composition need not specifically state that it is resistant to tearing to meet this limitation. For instance, the composition of Zama et al. is used for making oil seals and rubber hoses. To function in such utilities, a composition must inherently have a some resistance to tearing, for a rubber hose or an oil seal that tore quite easily, i.e. had no resistance to tearing, would be commercially useless. Similarly, if Brewer et al. is able to measure elongation, there must be some resistance to tearing, otherwise the composition would not be able to elongate.

The Examiner does note, however, that both coupling agents require at least 2 functional groups in view of the use of the plural word "groups". As such, compounds such as dimethylhexylamine and stearic acid, found in Zama et al., cannot be considered coupling agents. In addition, upon reconsideration, the partially hydrolyzed condensate of ethyl silicate cannot be considered a first coupling agent since it is unclear if this condensate has at least two hydroxyl groups. In view of this, coupled with applicants' remarks, the rejection over Zama et al. has been withdrawn.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Brewer et al.

5. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewer et al.

These rejections rely on the reasons of record. Applicants' traversal is not persuasive. The previous office action inadvertently rejected claims 3 and 6 under section 35 U.S.C. 103, rather than claims 4 and 6. However, a review of the paragraph detailing the rejection indicates that claim 4 was intended to be rejected, rather than claim 3. It is apparent that this was an obvious typographical error.

Applicants first state that Brewer et al. do not provide a teaching of the resistance to tearing. However, as indicated above and noted in the previous office action, the composition of Brewer et al. must inherently possess *some* degree of tear resistance. For instance, the composition of Brewer et al. is used to form automotive components, medical devices and sporting goods. Each of these requires a degree of tear resistance to be commercially viable. In addition, these compositions have improved elongation and to measure elongation, the composition obviously must not tear. Patentees need not have a "clear and particular disclosure regarding tear strength" to inherently anticipate the limitation "resistant to tearing".

The Examiner notes that while she specifically referred to compositions using compatibilizer 13 and 14 in her office action (because these met the specific limitation of claim 3), the epoxy functional and succinic anhydride functional compatibilizers used in the various working examples meet the general requirement of claim 1 for the second

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coupling agent since each of these compounds have groups that are suitable for reacting with hydroxyl groups.

Applicants' summary of Brewer et al. skips the fact that each of the silicone base compositions contain a hydroxyl containing organopolysiloxane, meeting the required first coupling agent. Note also that column 8, line 58, teaches that silanol terminal dimethylsiloxanes are useful compatibilizers. The PDMS 1 component contains vinyl groups and cures via a hydrosilylation reaction. Thus it does not appear that the hydroxyl terminated organopolysiloxane is suitable to react with the silicone rubber. Many of the compatibilizing agents used in these compositions contain groups that are suitable for reacting with a hydroxyl containing organopolysiloxane. The Examiner maintains that this anticipates the instant claims.

Applicants refer to compatibilizer 14 and states that this chemically reacts with the silicone rubber. First, it is not clear how applicants come to this conclusion as the Examiner does not see anything in Brewer et al. indicating such a reaction, and amino groups do not typically react in a Si-vinyl/Si-H cure system. Even so, there is nothing in the claims that would exclude such a reaction. The Examiner is also confused as to why applicants believe that compatibilizer 15 "plays the role of one coupling agent" when there is nothing indicating that this compatibilizer contains a functional group as required by the two coupling agents.

Since applicants have failed to distinguish between the claimed composition and the prior art, these rejections are maintained.

6. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within


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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
June 18, 2003

At first, the Examiner would like to note that applicants appear to be reading more limitations into the claims than are actually there. First, note that the second coupling agent need only have groups that are "suitable" for reacting with the hydroxyl first groups. This does not require that the prior art specifically state that the groups must undergo reaction with one another. Second, there is no requirement that the composition be homogeneous. Also, applicants appear to be reading more into the first coupling agent than is there. Since the claim defines this coupling agent as an organopolysiloxane having hydroxyl functional groups, this is all that is necessary to meet this compound. In addition, the Examiner notes that the phrase "resistant to tearing" is extremely broad and does not lend much in the way of limitations to this claim. For instance this does not require any degree of resistance and a composition need not specifically state that it is resistant to tearing to meet this limitation. For instance, the composition of Zama et al. is used for making oil seals and rubber hoses. To function in such utilities, a composition must have an inherent degree of resistance to tearing, for a rubber hose or an oil seal that tore quite easily, i.e. had no resistance to tearing, would be commercially useless. Similarly, if Brewer et al. is able to measure elongation, there must be some resistance to tearing, otherwise the composition would not be able to elongate.

The Examiner does note, however, that both coupling agents require at least 2 functional groups in view of the use of the plural word "groups". As such, compounds such as dimethylhexylamine and stearic acid, found in Zama et al., cannot be considered coupling agents. In addition, upon reconsideration, the partially hydrolyzed condensate of ethyl silicate cannot be considered a first coupling agent it is unclear if this condensate has at least two hydroxyl groups. In view of this, coupled with applicants' remarks, the rejection over Zama et al. has been withdrawn.

Claims 1, 3, 5, 7 and 8 are rejected under 35 USC 102 over Brewer.

Claims 4 and 6 are rejected under 35 USC 103 over Brewer.

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